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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/830,328	04/24/2001	Y. Tom Tang	PF-0628 USN	6729

7590
Incyte Genomics Inc
Legal Department
3160 Porter Drive
Palo Alto, CA 94304

05/13/2004

EXAMINER

LOCKARD, JON MCCLELLAND

ART UNIT	PAPER NUMBER
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1647

DATE MAILED: 05/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/830,328

Applicant(s)

TANG ET AL.

Examiner

Jon M Lockard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-20 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-6, 9-15, and 19 (each in part), drawn to polypeptides of SEQ ID NO:1, polynucleotides of SEQ ID NO:3, vectors, host cells, method of producing polypeptide, pharmaceutical composition comprising the polypeptide, and a method of treatment by administration of a pharmaceutical composition comprising the polypeptide.

Group II, claim(s) 7-8 (each in part), drawn to method of detecting the polynucleotide encoding SEQ ID NO:1.

Group III, claim(s) 16 in part, drawn to antibodies of SEQ ID NO:1.

Group IV, claim(s) 17 in part, drawn to an agonist of polypeptide of SEQ ID NO:1.

Group V, claim(s) 18 in part, drawn to an antagonist of polypeptide of SEQ ID NO:1.

Group VI, claim(s) 20 in part, drawn to method of treatment by administration of antagonist of polypeptide of SEQ ID NO:1.

Group VII, claim(s) 1,2, and 15 (each in part), drawn to polypeptides and a pharmaceutical composition comprising the polypeptide of SEQ ID NO:2.

Group VIII, claim(s) 3-6, 12-14 (each in part), as they pertain to polynucleotides encoding the polypeptide of SEQ ID NO:2; and 9-11 (each in part), as they pertain to SEQ ID NO:4, drawn to polynucleotides, vectors, host cells, and method of producing the polypeptide.

Group IX, claim(s) 7-8 (each in part), in so far as they are drawn to method of detecting the polynucleotide encoding SEQ ID NO:2.

Group X, claim(s) 16 in part, drawn to an antibody which specifically binds to the polypeptide of SEQ ID NO:2.

Group XI, claim(s) 17 in part, drawn to an agonist of SEQ ID NO:2.

Group XII, claim(s) 18 in part, drawn to an antagonist of SEQ ID NO:2.

Group XIII, claim(s) 19 in part, drawn to a method of treatment by administration of a pharmaceutical composition comprising the polypeptide of SEQ ID NO:2.

Group XIV, claim(s) 20 in part, drawn to method of treatment by administration of an antagonist of the polypeptide of SEQ ID NO:2.

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2. The inventions listed as Groups I-VI do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polypeptides, polynucleotides, vectors, host cells, and method of producing the polypeptide of Group I, the antibodies of Group III, the agonists and antagonists of the polypeptide of Groups IV and V respectively are structurally and functionally different chemical compounds, each of which can be made and used without the other compound. The methods of Groups II and VI require compounds which are functionally different from each other and each can be made and used without the other. Lack of unity is shown because these compounds lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

3. The inventions listed as Groups VII-XIV do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The polypeptides of Group VII, the polynucleotides, vectors, and host cells of Group VIII, the antibodies of Group X, and the agonists and antagonists of Groups XI and XII respectively are structurally and functionally different chemical compounds, each of which can be made and used without the other compound. The methods of Groups IX, XIII, and XIV require compounds which are functionally different from each other and each can be made and used without the other. Lack of unity is shown because these compounds lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

4. The inventions listed as Groups I-VI and Groups VII-XIV do not relate to a single inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: The compounds of Groups I-VI and the compounds of Groups VII-XIV are structurally and functionally different chemical compounds from each other, which can be made and used without the other compounds, and the methods of using the compounds of Groups I-VI and Groups VII-XIV are therefore also different methods. Lack of unity is shown because these compounds and methods lack a common utility which is based upon a common structural feature which has been identified as the basis for that common utility.

5. "A telephone restriction requirement was not made in this application due to an explicit request by Incyte and their policy of not making elections in response to telephonic restriction requirements."

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Jon M. Lockard, Ph.D.** whose telephone number is **(571) 272-2717**. The examiner can normally be reached on Monday through Friday, 8:00 AM to 6:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Gary Kunz, Ph.D.** can be reached on **(571) 272-0887**.

The fax number for the organization where this application or proceeding is assigned is **703-872-9306**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866-217-9197** (toll-free).

JML
May 10, 2004

Eileen B. O'Hara